

US Patent Application No. 10/600,052
Response to Office Action of February 13, 2006

Attorney Docket No. 31132.129
Client Reference No. PC877.19

REMARKS

Claims 1-25 were previously pending. Claims 26-34 have been added. Claims 21-25 have been withdrawn. Reconsideration of presently pending claims 1-20 and 26-34 is respectfully requested in light of the above amendments and the following remarks.

Election/Restrictions

Applicants affirm the election Group 1, claims 1-20. Applicants traverse the restriction requirement because of apparent inconsistent statements being made by the examiner.

- In the section of the Office action titled "Election/Restrictions", the Examiner identifies two inventions: a body member (claims 1-20) and an implantable endoprosthesis (claims 21-25). The Examiner states that "[t]he inventions are distinct."
- In the section of the Office action titled "Double Patenting", the Examiner compares the body member claims to the implant claims of U.S. Ser. No. 09/924,298. The Examiner states that the inventions are "not patentably distinct from each other."

Double Patenting

Claims 1-20 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 101-103, 106-110, 112-113 of copending Patent Application No. 09/924,298. Applicants acknowledge this provisional rejection and will address any double patenting issues if and when a double patenting problem comes to fruition.

§ 102 Rejections

U.S. Patent No. 5,534,029 to Weber

Claims 1-4, 6-9, and 17-20 were rejected under 35 U.S.C. § 102(b) as being anticipated

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by U.S. Patent No. 6,533,818 to Weber et al. ("Weber").

The PTO provides in MPEP § 2131 that

"[t]o anticipate a claim, the reference must teach every element of the claim...."

Therefore, to sustain the rejection of these claims Weber must teach all of the claimed elements. However, Weber fails to disclose all of the claimed elements of independent claims 1 and 20 and, therefore, dependent claims 2-4, 6-9, and 17-19.

With respect to amended claim 1, Weber at least fails to teach "wherein the body member is adapted to articulate with the shell such that one or more surfaces of the shell come into contact with the first component." In fact, Weber describes layers 12, 14 that are designed to prevent movement, not articulate with a shell. The layers 12, 14 "are made of bone permeable material. When implanted in the spine, bone will grow into these layers to form a strong bond *that prevents the disc from moving.*" Col. 4-5, Lines 65-1.(Emphasis Added).

Further and more generally, there is no indication that the layers 12, 14 in Weber may be used in combination with a shell or shell structure. In fact, Weber discloses that the layers 12, 14 "bond to the vertebral bone when implanted." Col. 4, Lines 60-61.

Amended independent claim 20 contains similar limitations to claim 1: "wherein the body member is adapted to articulate with respect to one or more surfaces of the shell structure of the endoprosthesis." Thus, Weber fails to teach all of the elements of claim 20 for at least the same reasons.

Therefore, the §102 rejections of claims 1-4, 6-9, and 17-20 are not supported by Weber. Thus, Applicants respectfully request Examiner withdraw these §102(b) rejections of claims 1-4, 6-9, and 17-20.

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§103 Rejections

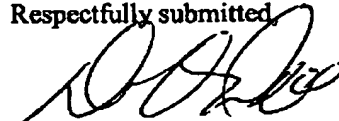
Claims 5 and 10-15 were rejected under 35 U.S.C. §103(a) as being unpatentable over Weber. However, as shown above Weber fails to teach all of the elements of independent claim 1 from which claims 5 and 10-15 depend and further limit. Thus, the §103 rejection of claims 5 and 10-15 over Weber cannot be supported.

CONCLUSION

It is clear from the foregoing that independent claims 1, 20, 26, and 34 are in condition for allowance. Dependent claims 2-19 and 27-33 depend from and further limit the independent claims and, therefore, are allowable as well.

It is believed that all matters set forth in the Office Action have been addressed, and that claims 1-20 and 26-34 are in condition for allowance. Favorable consideration and an early indication of the allowance of the claims are respectfully requested. Should the Examiner deem that an interview with Applicant's undersigned attorney would expedite consideration, the Examiner is invited to call the undersigned attorney at the telephone number indicated below.

Respectfully submitted,



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Dated: May 15, 2006

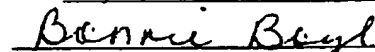
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Bonnie Boyle